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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,374	08/08/2007	Torsten Ziser	CH-8232/RC-235	2733
7590 Jennifer R. Seng Lanxess Corporation Law & Intellectual Property Department 111 RIDC Park West Drive Pittsburgh, PA 15275-1112			EXAMINER WANG, CHUN CHENG	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 05/10/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,374

**Applicant(s)**

ZISER ET AL.

**Examiner**

Chun-Cheng Wang

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 9-18 and 21-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9-18 and 21-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 02/01/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to the Amendment filed on 02/01/2010. Claims 5, 7, 8 and 19-20 have been cancelled. Claims 1-4, 6, 9-18 and 21-41 are now pending.
2. The objections and rejections not addressed below are deemed withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this section can be found in a prior Office Action.
4. New ground rejections applied necessitated by the amendment.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4, 6, 9-18 and 21-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "said non-crosslinkable organic media (A) ... having a boiling point of no less than 120°C" in line 3 through line 5 in claim 1 is not properly described in the application as filed.
7. Claim 40 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations “at least one non-crosslinkable organic media (A) is selected from the group consisting of: ... non-fluorinated polyether oils ... non-fluorinated silicon-containing oils” is not properly described in the application as filed. The specification does not specifically disclose non-fluorinated polyether oils or non-fluorinated silicon-containing oils. The general disclosure of polyether oils and perfluoropolyalkyl ethers (which is part of fluorinated ethers) in paragraph [0098]; and silicon-containing oils (no fluorinated silicon-containing oils disclosed) in paragraph [0101] of pre-grant publication US 2008/0064768 is not sufficient to be used for inclusion of non-fluorinated polyether oils and non-fluorinated silicon-containing oils or for exclusion of fluorinated polyether oils and fluorinated silicon-containing oils.

8. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The re-dispersion composition is not properly described in the application as filed. Example 4 disclose re-dispersion of the latex particles and particle size distribution (TABLE 13), however no “average particle diameter of less than 40 nm in the re-dispersion and being below an average particle diameter of the at least one microgel (B) in the latex” were disclosed.

***Claim Rejections - 35 USC § 102/103***

9. Claims 1-4, 6, 9, 12, 14, 16-18, 21-24, 26-28, 30 and 33-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamamoto et al. (US 6548454).

The rejections stand as per the reasons set forth in paragraph 10 of the previous Office Action, incorporated herein by reference.

Regarding newly added limitation “said non-crosslinkable organic media (A) ... having a boiling point of no less than 120°C” in Claim 1: Yamamoto is silent on the boiling point of the media (A).

Yamamoto further discloses the lubricant composition is to replace lubricating oil such as mineral oil (boiling point about 260°C-330°C) and poly- $\alpha$ -olefin oil or a lubricant such as grease for high temperature application without scattering or evaporation (column 1, lines 13-31). The base oil is fluorinated polymer oil will have boiling point of no less than 120°C.

Regarding the diameter deviation is of the same individual primary particle in Claim 1: Yamamoto is silent on the deviation of the particle diameters. Yamamoto further discloses “the ultrafinely particulate organic material is spherical” (column 3, lines 28-30). In light of the disclosure, one ordinary skilled would anticipate the ultrafine particulate organic material has the claimed particle diameter deviation.

“When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Claims 9 and 26: Yamamoto also discloses because of its crosslinked structure, the ultrafinely particulate organic material, when mixed with various solvents, takes the solvent into its crosslinked structure to swell rather than being dissolved in the solvent (read on insoluble in toluene at 23°C) (column 15, lines 36-39).

Claim 17: Yamamoto further discloses the surface of the ultrafinely particulate organic material may be modified with a functional group such as a polymerizable C=C group (column 16, lines 4-12).

***Allowable Subject Matter***

10. Claims 10, 11, 13, 15, 25, 29, 31, 32 and 38-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

11. Applicant's arguments filed 08/28/2009 have been fully considered but they are not persuasive.

12. Regarding rejections under 35 U.S.C. 102(b) anticipated by Obrecht et al (US 6399706): Applicant argued: Claim 1 provides "for a deviation between the diameters of an individual primary particle of less than 250% ... diameter of the same individual primary particle".

Response: The microgel particles are manufactured from latex (column 3, lines 6067) in surfactant (column 4, lines 28-43), the particles formed is spherical and have diameter deviation of the same particle less than 250%.

13. Regarding rejections under 35 U.S.C. 102/103 over Yamamoto et al. (US 6548454):

Applicant argued: Yamamoto failed to disclose a composition comprises microgel having a deviation of a particle's diameter as claimed".

Response: Yamamoto discloses "the ultrafinely particulate organic material is spherical" (column 3, lines 28-30), which will have deviation of a particle's diameter as claimed.

14. The unexpected result Applicant alleged is based on the comparison of the microgel composition against commercial greases (e.g. non-microgel composition), which is not compatible with the microgel compositions of Obrecht and Yamamoto.

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun-Cheng Wang whose telephone number is (571)270-5459. The examiner can normally be reached on Monday to Friday w/alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571)272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/  
Primary Examiner, Art Unit 1796

/Chun-Cheng Wang/  
Examiner, Art Unit 1796

/CCW/